



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,232	08/03/2001	Samuel Sergio Tenenbaum	2875/IG342-US1	7566

7590

09/27/2002

DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/922,232

Applicant(s)
Samuel Sergio TENEBBAUM

Examiner
Stephen M. Gravini

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-25-02
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 and 58-62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 and 58-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other: _____

Art Unit: 3622

DETAILED ACTION

Priority

1. At any time before the patenting or abandonment of or termination of proceedings on an earlier nonprovisional application, an applicant may have recourse to filing a continuation in order to introduce into the application a new set of claims and to establish a right to further examination by the Office. In addition, a continuation or divisional application may only be filed under 37 CFR 1.53(d) if the prior nonprovisional application is:

- (A) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by 37 CFR 1.51(b);
- (B) a design application that is complete as defined by 37 CFR 1.51(b); or
- (C) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371.

The Office cannot grant continuing status of a present application because the parent application is not a nonprovisional application that may be filed under Rule 53(d) listed supra.

2. The following is law from 35 U.S.C. 119(e):

- (1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific

Art Unit: 3622

reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

(2) A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

However, the provisional application upon which priority is claimed was filed more than one year prior to the filing of the present application. Domestic priority can not be granted under Code 119(e) because the present application was not filed earlier than 12 months under section 111(a) or section 363 of title 35.

Requirements for Information

4. The following is a rule from 37 CFR 1.105:

(a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (i) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
- (v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

Art Unit: 3622

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and /or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

5. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

In response to this requirement, please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of intrusive internet advertising known as Shoshkele.

In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation of the reliance placed on that publication in distinguishing the claimed subject matter from the prior art.

In response to this requirement, please state the specific improvements of the subject matter in claims 1-52 and 58-62 over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those

Art Unit: 3622

improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts.

Examiner is particularly interested in Rule 105 criteria (a)(1)(ii)-(vii), since it appears the present invention is an improvement on the old and well known art of internet pop-up advertising. It appears that applicant has not conducted a prior art search nor asserted how advertising material found on Yahoo.com was rigidly compared such that at least one of the claims was unquestionably infringed. For a quality examination, the Office is requiring:

- information used to draft the application;
- information used in the invention process, such as by designing around or providing a solution to published features of Shoshkele to accomplish the claimed invention; and
- identification of what is being improved by the claimed invention.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the

Art Unit: 3622

scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 33 is rejected under 35 U.S.C. 101 because it recites a system (machine) depending on a method (process), which are separate classification categories of inventions. This statute allows for patenting of either a process or a machine, but not both. Examiner considers the

Art Unit: 3622

recited "the system of claim 1" to be a machine and considers the recited "method for modifying an image" to be a process. Since claim 33 attempts to seek patenting of two categories of inventions under a single patent, it is rejected as containing non-statutory subject matter.

However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen, communicating a tag to a character controlling server based on client server communications, and selecting a character, greeting, recipient and message. Those features are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner does not find basis in the specification to enable the claimed features of introducing or displaying a multimedia animated character into a computer screen, communicating a tag to a

Art Unit: 3622

character controlling server based on client server communications, and selecting a character, greeting, recipient and message such that the invention is enabling. Since each of the depending claims are dependent upon non-enabling subject matter, all are also rejected as being non-enabling. Also claims 7, 10, 19, 20, 29, 32, 38, 41, 46, 51, and 62 are non-enabling because the specification does not allow one skilled in the art of computer display to define a plurality of characters which are selected and controlled according to information from the user's computer which is not under the user's control and technical features available in the user's computer or wherein an HTML page being viewed by a user was received from a content provider's server and the character is introduced therein as result of tags left in the page by the content provider. The user control (or lack thereof) is not enabling because a user always has control of a computer and one skilled in the art would not be able to enable an uncontrollable computer. The tag is not enabling because one skilled in the art would not be able to use the tags as claimed based on the specification. However, in order to consider these claims in light of the prior art, examiner will assume that these features are enabling by the specification.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3622

applicant regards as the invention. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen, communicating a tag to a character controlling server based on client server communications, and selecting a character, greeting, recipient and message which do not have antecedent basis from the specification. Those features fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of the lack of an antecedent basis. Since each of the depending claims are dependent upon indefinite subject matter, all are also rejected as being indefinite. Also claims 7, 10, 19, 20, 29, 32, 38, 41, 46, 51, and 62 are indefinite because the specification does not provide antecedent basis to define a plurality of characters which are selected and controlled according to information from the user's computer which is not under the user's control and technical features available in the user's computer or wherein an HTML page being viewed by a user was received from a content provider's server and the character is introduced therein as result of tags left in the page by the content provider. The user control (or lack thereof) is indefinite because a user always has control of a computer and the specification does not provide antecedent basis such that one would not be able to define an uncontrollable computer. The tag is indefinite because the specification does not provide antecedent basis such that one would be able to use the tags as claimed. However, in order to consider these claims in light of the prior art, examiner will assume that these features are not indefinite by having an antecedent basis from the specification.

Art Unit: 3622

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Werkhoven (WO 99/59097), Landsman et al. (WO 99/60504), Krishan et al. (WO 00/30003), or Robinson (WO 00/42593) and are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cohen et al. (US 5,373,440), Petrecca et al. (US 5,781,894), Reilly et al. (US 5,740,549), Alberts (US 5,937,392), or Schena et al. (US 5,946,646), and are rejected under 35 U.S.C. 102(e) as

Art Unit: 3622

being clearly anticipated by Wexler et al. (US 5,960,409), or non patent literature references “Attention, please” by Susan Kuchinskias or “PC pop-up ads” by J. Dee Hill.

14. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The company information posted on one of the assignee web sites states that in 1999 the concept of Shoshkele was created as a technology innovation. The specification recites “advertising is presented on a computer screen in the form of an animated multimedia character that will be referred to as a ‘shoshkele’.” This recitation is essentially the claimed invention and has been disclosed in public use since 1999. Since the present application was filed in 2001, which is more than one year permitted under 35 USC 102(b), it is statutorily barred from being patented.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3622

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of Juno Online Services (hereinafter JUNO) method of computer multimedia advertising. Since at least 1997, JUNO has performed the claimed method comprising:

introducing or displaying into a computer screen a multimedia animated character;
sending content from a server to a client and providing a tag communicating to a character controlling server (or media source); and
selecting a multimedia animated character, greeting, recipient and sending the character.

Examiner also has personal knowledge of the claimed translational movement, uppermost character display on a multilayer screen, overlaying and transparent charactering, sound display, signal control generation including basis on a user computer, network connectivity and command sending, browser and HTML viewer use, executable code installed in media or file, and payment based on volume or duration access. The claimed introducing or displaying into a computer

Art Unit: 3622

screen a multimedia animated character occurs when the examiner accessed JUNO's free electronic mail account in which the examiner was presented with a multimedia animated character (known as a pop-up advertisement). The claimed sending content from a server to a client and providing a tag communicating to a character controlling server (or media source) occurs when JUNO would gather demographics associated with examiner user response data to send advertisement presentations based on examiner demographic data and correlating that data to advertisers who would historically target that demographic variable data or tag. The claimed selecting a multimedia animated character, greeting, recipient and sending the character occurs when examiner would compose and send an e-mail alerting others to the pop-up advertisement provided by JUNO advertisers. The claimed invention, recited by the applicants, has been provided by JUNO long before the filing of applicants' invention except for the intrusive, unpredictable, and uncontrollable nature of the character. Examiner notes that it is old and well known to those skilled in the art of computer multimedia advertising, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the intrusive, unpredictable, and uncontrollable nature of a character since the intrusive, unpredictable, and uncontrollable feature is merely non-functional descriptive language which is not functionally involved in the steps recited. The introducing or displaying into a computer screen a multimedia animated character would be performed the same regardless of the nature of the character. To one of reasonable skill in the art of computer multimedia

Art Unit: 3622

advertising, most pop-up advertisements, as claimed by the applicant are intrusive, unpredictable, and uncontrollable. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to present a multimedia animated character having any type of nature because such a nature does not functionally related to the steps in the invention claimed and because the subjective interpretation of the nature does not patentably distinguish the invention. The motivation to combine applicants claimed invention with the examiner's personal knowledge of JUNO is to allow advertisers greater targeting capabilities, while transferring information more efficiently, which clearly shows the obviousness of the claimed invention.

Conclusion

18. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
September 24, 2002